

REMARKS

A New Declaration is Not Required

Applicants remind the Examiner that “[t]he Office no longer checks the date of execution of the oath or declaration and the Office will no longer require a newly executed oath or declaration based on an oath or declaration being stale ... or where the date of execution has been omitted.” MPEP §602.05. The declaration that was submitted was for the present application (10/776,643), thus the declaration complies with 37 C.F.R. §1.63(e). The submitted declaration was executed because all the inventors signed, thus the declaration complies with 35 U.S.C. §115. Accordingly, a new declaration is not required.

The undersigned left a voice message with the Examiner’s supervisor explaining Applicants’ position and quoting the MPEP, with respect to the requirements of an oath or declaration. In a voice message from Examiner Desai to the undersigned, left on 22 April 2009, the Examiner indicated that a new oath or declaration was not required for this case. The undersigned thanks the Examiner for reviewing and confirming the requirements for an oath or declaration.

The Objections to the Specification are Moot

The Office Action objected to the specification as not including a sequence listing and requested Applicants to submit a sequence listing. Applicants have included a sequence listing to recite the amino acid sequence that is referenced as GenBank accession number 230520, publicly available through NCBI (National Center for Biotechnology Information) website. Applicants thank the Examiner for the suggestion for amending the specification to include a sequence listing.

The Double Patenting Rejection is Improper

The Office rejected claim 57 under an obviousness-type double patenting rejection over claim 8 of issued patent 6,855,556 (filed as U.S. Application No. 10/040,077). In particular, the Examiner indicates that the claims of the U.S. Patent are drawn to a composition comprising a

least one mutated glucose/galactose binding protein ... [comprising] at least two amino acid substitutions ... that includes a cysteine at position 112 and a serine at position 238.” *Office Action of 18 February 2009*, page 4. Applicants respectfully point out that the issued claims are actually drawn to a glucose biosensor and not a composition.

This distinction between a composition (as currently claimed) and a glucose biosensor was highlighted in a restriction requirement was mailed on 25 February 2003 for 10/040,077. In the Restriction Requirement the Examiner required restriction among Group I (claims 1-16 and 34-40), a biosensor comprising a ... mutated binding protein ..., Group II (claims 17-33), a method of determining glucose and Group III (claims 41-47), a composition comprising glucose/galactose binding protein *See Restriction Requirement of 25 February 2003 in USSN 10/040,077*, page 2. In a second Restriction Requirement dated 27 May 2003, the Examiner again required restriction between Group I (claims 1-16), a glucose biosensor and Group II (claims 34-40), a composition comprising glucose/galactose binding protein *See Restriction Requirement of 27 May 2003 in USSN 10/040,077*, page 2. Both Restriction Requirements are attached hereto.

Applicants elected Group I, the biosensor, in both instances in the parent application. Applicants are now prosecuting the composition claims, which were previously restricted out. It is also noteworthy that, at the time restriction was required in the parent application, many of the Group I claims (the biosensor) contained this limitation that the mutant protein contained in the biosensor comprise at least two amino acid substitutions that include a cysteine at position 112 and a serine at position 238 claims. Moreover, the Group II or III claims (the composition claims) also contained the limitation that the mutant protein comprises at least two amino acid substitutions that include a cysteine at position 112 and a serine at position 238 claims. Yet, the Examiner required restriction between the biosensor and the composition claims in both restriction requirements. The compositions in the present claims also contain this limitation that the mutant proteins comprise at least two amino acid substitutions that include a cysteine at position 112 and a serine at position 238 claims. Accordingly, Applicants assert that the double

patenting rejection in the present application is improper under 35 U.S.C. §121 and should be withdrawn. Applicant respectfully requests reconsideration and withdrawal of the double-patenting rejection.

The Written Description Rejection Should be Withdrawn

The Office Action of 18 February 2009 rejected claims 57, 78 and 79 because the claims allegedly “contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” *Office Action*, page 5. Applicants respectfully disagree. Nonetheless, Applicants have amended claim 57 to include a reference to SEQ ID NO:1, which is the identical amino acid sequence to the amino acid sequence of GenBank accession number 230520, referenced in paragraph 0025 of the originally filed application. Applicants submit that the specification describes the full scope of the currently claimed invention, which now refers to a specific amino acid sequence by a sequence identification number. Applicants respectfully request reconsideration and withdrawal of the written description rejection.

CONCLUSION

Applicants have amended claim 57 to better capture the envisioned commercial embodiments and assert that the amendments render moot the written description rejection. Applicants have also amended the specification to include a sequence listing. Applicants respectfully request reconsideration and withdrawal of all outstanding rejections to the claims.

Should the Examiner believe that further discussion of any remaining issues would advance the prosecution, he or she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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